

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent of Applications in Internet Time, LLC
Patent No.: 8,484,111

Title: INTEGRATED CHANGE MANAGEMENT UNIT

Ex Parte Reexamination Control No.: 90/019,069

Filing Date: April 1, 2022

Art Unit: 3992

**PATENT OWNER'S PETITION FOR SUSPENSION OF THE RULES
AND FOR SUMMARY TERMINATION OF REEXAMINATION,
AS A MATTER OF LAW, PURSUANT TO
37 C.F.R. §§ 1.181, 1.182, and 1.183**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Patent Owner hereby petitions the Commissioner of Patents to summarily and immediately terminate this reexamination. Such termination is sought on the grounds that conducting this reexamination would be contrary to law and regulation. Further, as explained below, an extraordinary situation exists, and justice requires waiver of any regulations that would otherwise prevent granting this relief.

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I. Procedural Background

On November 8, 2013, Patent Owner filed its complaint for infringement of U.S. Patent Nos. 8,484,111 (the '111 patent) and 7,356,482 (the '482 patent) against Salesforce.com, Inc. ("Salesforce" or "Requestor"), the requestor of the present reexamination, in the District of Nevada. *See Applications in Internet Time LLC v. Salesforce.com, Inc.*, No. 3:13-CV-00628-RCJ-VPC (D. Nev.) (filed Nov. 8, 2013).

On August 1, 2014, Salesforce filed a petition for covered business method review (CBM) of claims 13-18 of the '111 patent. The CBM was assigned case number CBM2014-00162.

On August 4, 2014, Salesforce filed a petition for CBM against claims 1-59 of the '482 patent. This CBM was assigned case number CBM2014-00168.

On February 2, 2015, the Patent Trial and Appeal Board (PTAB or Board) issued decisions denying institution in both CBMs, determining that Salesforce failed to establish that the patents qualify as covered business method patents under section 18 of the AIA.

On August 17, 2015, to help its client Salesforce which was now time-barred, RPX Corporation ("RPX") filed three additional follow-on petitions that the Board would later find to be abusive. These included a petition for *inter partes* review of claims 13-18 of the '111 patent that was assigned case number IPR2015-01750 (the '1750 IPR); a petition for *inter partes* review of claims 1, 7, 8, 10-21, 27-37, and 38-40 of the '482 patent that was assigned case number IPR2015-01751 (the '1751 IPR); and a petition for *inter partes* review of claims 3-6 and 22-26 of the '482 patent that was assigned case number IPR2015-01752 (the '1752 IPR). RPX's petitions failed to reveal the crucial fact that Salesforce was actually a real party in interest (RPI). Had the petitions properly identified Salesforce as an RPI, the PTAB would have known the

petitions were time-barred pursuant to 35 U.S.C. § 315(b) because Salesforce was served with a complaint alleging infringement of the patents more than one year before the filing of the petitions.

On May 12, 2016, believing Salesforce was not an RPI and that the petitions were thus not time-barred, the Board instituted review in all three IPRs.

On December 28, 2016, the Board issued final written decisions in the IPRs. Each decision determined petitioner demonstrated by a preponderance of the evidence that the challenged claims were unpatentable. Under § 315(e)(1), this caused estoppel to attach to Salesforce (as an actual RPI) upon issuance of the final written decisions.

On February 27, 2017, Patent Owner appealed to the Federal Circuit. The appeals challenged the Board's determinations that the challenged claims were unpatentable. The appeals also challenged the Board's determination that Salesforce was not a real party in interest and not time-barred pursuant to § 315(b).

On July 9, 2018, the Federal Circuit issued its decision on appeal (unsealed July 24, 2018), remanding back to the Board. See *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018).

On September 4, 2020, the IPRs were repaneled to a panel of the most senior administrative patent judges available at the Board, in view of the significant and broad implications raised in these cases on remand.

On October 2, 2020, the repaneled Board issued judgments terminating all three IPRs. The judgments determined Salesforce was an RPI and thus the petitions were time-barred under § 315(b). The judgments further determined that discretionary denial of the petitions was warranted based on Salesforce's abusive filing practices.

On April 1, 2022, despite being estopped under § 315(e)(1), Salesforce resumed its abusive filing practices the Board rejected a year and half earlier. In particular, Salesforce filed yet another post-grant challenge (a request for *ex parte* reexamination this time) against the same claims of the same '111 patent using some of the same grounds as its refused and abusive CBM and IPR petitions. The reexamination proceeding was assigned control no. 90/019,069 (the '069 reexamination) and was accorded a filing date of April 1, 2022.

On April 14, 2022, again despite being estopped under § 315(e)(1), Salesforce further continued the abusive filing practices the Board rejected a year and half earlier. This time, Salesforce filed a request for *ex parte* reexamination of the same claims of the '482 Patent using some of the same grounds as its refused and abusive CBM and IPR petitions. The reexamination proceeding was assigned control no. 90/019,070 (the '070 reexamination) and was accorded a filing date of April 14, 2022.

On May 13, 2022, an order granting reexamination of claims 13-18 of the '111 patent in the '069 reexamination was mailed by the Office. The order acknowledges, at page 21, that “prior art and arguments cited in the Request are substantially the same as that presented in the IPR2015-01750 petition”.

On May 25, 2022, an order granting reexamination of claims 1, 10, 20, 21, 23-26, 30, and 40 of the '482 patent in the '070 reexamination was mailed by the Office. The order acknowledges, at page 8, that “[t]he grounds asserted ... in the instant reexamination request are based on the same prior art and arguments presented in the IPR petitions” in IPR2015-01751 and IPR2015-01752.

II. This Reexamination Should Be Terminated Pursuant to *In re Vivint* Due to Abusive Filing Practices Already Found By the PTAB

The present case involves the extraordinary circumstance where the Requestor is resubmitting grounds the Board already denied as abusive in an IPR. The Federal Circuit *requires* termination of such a reexamination: “the Patent Office, when applying § 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive.” *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021). The present reexamination request is even more abusive than *Vivint* because here the Requestor (Salesforce) colluded with another party (RPX) who filed the previous IPR under RPX’s name without disclosing that Salesforce—which had already filed an AIA petition and was time-barred—was actually the real party in interest (RPI) in the IPR.

Unbelievably, Salesforce is back yet again, with a reexamination request that mainly re-presents the same grounds already found abusive in the earlier IPR filed by Salesforce/RPX.

Here, just as in *Vivint*, the present reexamination must be terminated because it presents grounds that the Board (including the Chief APJ and the Vice Chief APJ) already denied as involving abusive filing practices. The Board denied the IPRs after explicitly finding abuse by Salesforce and RPX. For example, the Board found:

- Salesforce filed a CBM petition against the challenged ‘111 patent, and the petition was denied;
- Salesforce was time-barred from filing further AIA petitions against the ‘111 patent;
- Salesforce paid RPX substantial sums of money;
- “Salesforce’s relationship with RPX was based, at least in part, on efforts to address the same patents asserted against Salesforce by AIT in litigation and also challenged by RPX in these IPRs, to the benefit of Salesforce;”

- RPX filed a follow-on IPR petition without disclosing that Salesforce was the real party in interest; and
- “RPX’s filings of these Petitions were strategically motivated, at least in part, to provide a second chance at invalidating the AIT patents to benefit Salesforce, which was time-barred from filing any additional petitions.”

IPR2015-01750, Paper 128, at 22-23 and 38-40 (PTAB Oct. 2, 2020) (precedential). Likewise, the Federal Circuit found “the evidence submitted indicates [RPX]’s understanding that the very challenges to validity included in the IPR petitions were challenges Salesforce would like to have made if not time-barred from doing so” *AIT*, 897 F.3d at 1355

In more gruesome detail, the Board found the following abusive IPR filing practices by Salesforce and RPX against the ‘111 patent subject to the present reexamination, explicitly using the word “abuse”:

Salesforce previously filed petitions for CBM patent review of the ‘111 and ‘482 patents in August 2014, which were denied institution in early February 2015. Salesforce [redacted] member of RPX, and has paid RPX substantial sums as membership fees [redacted]. Additionally, there were multiple communications between RPX and Salesforce employees in which the AIT-Salesforce Litigation involving these patents was mentioned or discussed.

The facts support that RPX’s filings of these Petitions were strategically motivated, at least in part, to provide a second chance at invalidating the AIT patents to benefit Salesforce, which was time-barred from filing any additional petitions. RPX’s insistence that it filed the Petitions only “to pursue its own interests” (Pet. Remand Br. 36; *id.* at 36–47), is insufficiently credible on this record. We consider the circumstances present here to implicate the **abuse** and strategic advantage concerns, between two significantly related parties, that our precedent permits us to avoid by exercising our discretion to deny institution.

IPR2015-01750, Paper 128, 39-40 (PTAB Oct. 2, 2020) (precedential) (emphasis added).

In the '1750 IPR, the Board found that termination of the proceeding was a “warrant[ed] exercise of [their] discretion under 35 U.S.C. § 314(a) to deny review of the Petitions”. IPR2015-01750, Paper 128, 38 (PTAB Oct. 2, 2020) (precedential).

The present reexamination request is even more abusive than the '1750 IPR petition because, as in *Vivint*, the reexamination request is another “iteration of” the IPR petition which the Board already found to be abusive. *Vivint*, 14 F.4th at 1353 (“the *ex parte* reexamination request was a more egregious abuse than the '091 petition” because it was another “iteration of” the “undesirable, incremental petitioning” practice that the Board found to be abusive with respect to that petition). To wit, in ordering the present reexamination, the Office acknowledged that “prior art and arguments cited in the Request are substantially the same as that presented in the IPR2015-01750 petition.” Order Granting Reexamination at 21 (May 13, 2022).

Thus, the present reexamination must be terminated pursuant to § 325(d) and *Vivint* because the Patent Office “cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive.” *Vivint*, 14 F.4th at 1354. “It would be arbitrary and capricious for the Patent Office to do anything ... other than terminate the reexamination.” *Vivint*, 14 F.4th at 1352.

III. Reexamination Should Be Terminated Because Requestor Salesforce is Estopped From Requesting or Maintaining the Present Reexamination Under 35 U.S.C. § 315(e)(1)

Patent Owner requests that the Office vacate the '069 reexamination because Requestor Salesforce is estopped, under 35 U.S.C. § 315(e)(1), from requesting or maintaining the '069 reexamination.

Section 315(e)(1) provides (emphasis added):

PROCEEDINGS BEFORE THE OFFICE.-The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under [35 U.S.C.] 318(a), or **the real party in interest** or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

The statutory estoppel provisions of § 315(e)(1) prohibited Requestor Salesforce from filing its Request in the present reexamination proceeding.

A. The third-party requester of the present *ex parte* reexamination proceeding was a real party in interest of the petitioner in the ‘1750 IPR

Requestor in the present reexamination is Salesforce.com, Inc. (“Salesforce”). *See* Request at 1. In the ‘1750 IPR, the named petitioner was RPX Corporation (“RPX”), and the Board determined that Salesforce, the present Requestor, was a real party in interest. *See* IPR2015-01750, Paper 128 (Judgment) at 3 (PTAB Oct. 2, 2020) (designated precedential) (“we determine that Salesforce is a real party in interest of RPX”).

Accordingly, the requestor of the present reexamination was a real party in interest of the petitioner in the prior IPR. As the real party in interest in the ‘1750 IPR, Salesforce became subject to § 315(e)(1) estoppel “effective as of the issuance of the [final] written decision” in the ‘1750 IPR. *Intuitive Surgical, Inc. v. Ethicon LLC*, No. 2020-1480, -- F.4th --, 2022 WL 421189, slip op. at 12 (Fed. Cir. Feb. 11, 2022).

B. The grounds raised in the present *ex parte* reexamination proceeding were raised or reasonably could have been raised during the ‘1750 IPR

The Federal Circuit has explained that statutory estoppel under § 315(e)(1) applies “to claims and grounds asserted in the petition”, and also “to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.”

California Inst. of Tech. v. Broadcom Ltd., 25 F.4th 976, 991 (Fed. Cir. 2022).

Courts, PTAB, and OPLA have interpreted the phrase “reasonably could have raised” in § 315(e)(1) to mean “any patent or printed publication that a petitioner actually knew about or that ‘a skilled searcher conducting a diligent search reasonably could have been expected to discover.’” *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924–25 (S.D. Cal. 2019) (collecting cases); see also *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) (references that petitioner was aware of when filing the petition reasonably could have been included in the petition); *IBM Corp. v. Intellectual Ventures II LLC*, IPR2014-01465, Paper No. 32, 6 (PTAB Nov. 6, 2015) (art that petitioner “reasonably could have raised” under § 315(e)(1) “include[es] ‘prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.’” (quoting 157 Cong. Rec. S1375)); Ex Parte Reexamination Control No. 90/014,292, DECISION GRANTING PETITION AND *SUA SPONTE VACATING EX PARTE REEXAMINATION PROCEEDING* (OPLA Feb. 5, 2020).

All the grounds in the present reexamination are the same as the claims and grounds asserted in the ‘1750 IPR petition (grounds 1-3) or reasonably could have been asserted against the same claims included in the petition (grounds 4-12), as shown in the following table and explained below:

Request in ‘069 Reexamination	‘1750 IPR
Ground 1: <ul style="list-style-type: none"> • Claims 13-18 • Reference: Popp 	Same as Ground 1 of the ‘1750 IPR: <ul style="list-style-type: none"> • Claims 13-18 (same) • Reference: Popp (same)
Ground 2: <ul style="list-style-type: none"> • Claims 13-18 • Reference: Kovacevic 	Same as Ground 2 of the ‘1750 IPR: <ul style="list-style-type: none"> • Claims 13-18 (same) • Reference: Kovacevic (same)
Ground 3: <ul style="list-style-type: none"> • Claims 13-18 • Refs.: Balderrama, Java Complete 	Same as Ground 3 of the ‘1750 IPR: <ul style="list-style-type: none"> • Claims 13-18 (same) • Refs.: Balderrama, Java Complete (same)

<p>Ground 4:</p> <ul style="list-style-type: none"> • Claims 13-18 • Reference: Haverstock 	<p>Reasonably could have raised in ‘1750 IPR:</p> <ul style="list-style-type: none"> • Claims 13-18 (same as in ‘1750 IPR). • Haverstock was actually known to petitioner prior to filing the ‘1750 IPR petition. <i>See</i> IPR2015-01750, Paper 1 (Petition) at 3 (petitioner citing to CBM2014-0162 in which Haverstock was raised); CBM2014-00162, Paper 1 (PTAB Aug. 1, 2014) (raising Haverstock).
<p>Grounds 5-8:</p> <ul style="list-style-type: none"> • Claims 13-18 • References: <ul style="list-style-type: none"> ○ Popp (Ground 1), ○ Kovacevic (Ground 2), ○ Balderrama (Ground 3), ○ Java Complete (Ground 3), ○ Haverstock (Ground 4), and ○ Amati 	<p>Reasonably could have raised in ‘1750 IPR:</p> <ul style="list-style-type: none"> • Claims 13-18 (same as in ‘1750 IPR) • Popp, Kovacevic, Balderrama, and Java Complete were actually raised in the ‘1750 IPR (see above). • Haverstock was actually known to petitioner prior to filing the ‘1750 IPR petition (see above). • Amati reasonably could have been raised in the ‘1750 IPR because a skilled searcher conducting a diligent search reasonably could have been expected to discover Amati prior to the filing of the ‘1750 IPR petition. Exhibit A (Declaration of Terry W. Kramer, Esq.), ¶ 24 (“based on my knowledge, experience, and expertise in conducting prior art searches, a skilled searcher conducting a diligent search for claims 13-18 of the ‘111 patent reasonably could have been expected to discover Amati during the time period from November 20, 2013 through August 17, 2015”); <i>see also</i> Request at 108 (Requestor’s representation that “a POSITA would have been able to locate Amati after exercising reasonable diligence”).
<p>Grounds 9-12:</p> <ul style="list-style-type: none"> • Claims 13-18 • References: <ul style="list-style-type: none"> ○ Popp (Ground 1), ○ Kovacevic (Ground 2), ○ Balderrama (Ground 3), 	<p>Reasonably could have raised in ‘1750 IPR:</p> <ul style="list-style-type: none"> • Claims 13-18 (same as in ‘1750 IPR). • Popp, Kovacevic, Balderrama, and Java Complete were actually raised in the ‘1750 IPR (see above).

<ul style="list-style-type: none">○ Java Complete (Ground 3),○ Haverstock (Ground 4), and○ Kerschberg	<ul style="list-style-type: none">• Haverstock was actually known to petitioner prior to filing the ‘1750 IPR petition (see above).• Kerschberg reasonably could have been raised in the ‘1750 IPR because a skilled searcher conducting a diligent search reasonably could have been expected to discover Kerschberg prior to the filing of the ‘1750 IPR petition. Exhibit A (Declaration of Terry W. Kramer, Esq.), ¶ 31 (“based on my knowledge, experience, and expertise in conducting prior art searches, a skilled searcher conducting a diligent search for claims 13-18 of the ‘111 patent reasonably could have been expected to discover Kerschberg during the time period from November 20, 2013 through August 17, 2015”); <i>see also</i> Request at 117 (Requestor’s representation that “a POSITA would have been able to locate Kerschberg after exercising reasonable diligence”).
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The Request’s grounds 1-3 are based on the exact same references (Popp, Kovacevic, Balderrama, and Java Complete) that Requestor (as a real party in interest) raised during the ‘1750 IPR and the Board addressed in the Final Written Decision issued on December 28, 2016 in the ‘1750 IPR.

In addition, the Request’s ground 4 raises a reference (Haverstock) that reasonably could have been raised during the ‘1750 IPR because Salesforce and RPX both knew of the reference before the filing of the petition in the ‘1750 IPR. *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) (references that petitioner was aware of when filing the petition reasonably could have been included in the petition); Ex Parte Reexamination Control No. 90/014,292, DECISION GRANTING PETITION AND *SUA SPONTE* VACATING *EX PARTE*

REEXAMINATION PROCEEDING, 14 (OPLA Feb. 5, 2020) (“[T]he issue of what prior art reasonably could have been raised need not be further addressed if the patent owner provides evidence, for example, that a reference was known to the requester at a time when it could have been raised in the *inter partes* review, such as, e.g., prior to the filing of the petition for *inter partes* review.”).

Haverstock was known to Salesforce (Requestor) prior to the filing of the petition for *inter partes* review. The ‘1750 IPR petition was filed on August 17, 2015. *See* IPR2015-01750, Paper 1. Haverstock was known to Salesforce prior to this date at least because Salesforce cited Haverstock in its August 1, 2014, petition for covered business method review of the same patent. *See* CBM2014-00162, Paper 1 (PTAB Aug. 1, 2014). Because Salesforce was an RPI with RPX in the IPR petition, and Salesforce was well aware of the Haverstock ground from its own earlier CBM petition, the Haverstock ground could have reasonably been raised in the IPR.

The Haverstock ground from the earlier CBM was also known to RPX at the time RPX filed the IPR petition. RPX’s IPR petition specifically referenced the CBM. IPR2015-01750, Paper 1 at 3 (“Institution of covered business method patent review of the ‘111 patent was also denied in *Salesforce.com, Inc. v. Applications in Internet Time LLC*, No. CBM2014-0162.”). For this additional reason, ground 4 of the present reexamination request could have reasonably been raised in the IPR along with grounds 1-3 which were actually raised.

The remaining grounds (grounds 5-12) build from grounds 1-4 and add two additional references, Amati and Kerschberg, against the same claims. A diligent search reasonably could have been expected to discover both Amati and Kerschberg. The Declaration of Terry W. Kramer, Esq., attached hereto as Exhibit A, demonstrates the ease with which a skilled searcher would have found Amati and Kerschberg prior to the filing of the petition in the ‘1750 IPR on

August 17, 2015. *See, e.g.*, Exhibit A (Declaration of Terry W Kramer, Esq.) at ¶¶ 16-31. Mr. Kramer concludes “based on my knowledge, experience, and expertise in conducting prior art searches, a skilled searcher conducting a diligent search for claims 13-18 of the ‘111 patent reasonably could have been expected to discover Amati” and “Kerschberg during the time period from November 20, 2013 through August 17, 2015”). *Id.* at ¶¶ 24, 31. The reexamination Request itself represents “a POSITA would have been able to locate Amati after exercising reasonable diligence” and “a POSITA would have been able to locate Kerschberg after exercising reasonable diligence.”¹ Request at 108 and 117.

Because Requestor knew of all the references (except possibly Amati and Kerschberg) during its earlier IPR proceedings, and would have been able to discover Amati and Kerschberg with reasonable diligence, grounds 4-12 reasonably could have been raised during the prior *inter partes* review. *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924–25 (S.D. Cal. 2019) (collecting cases); see also *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) (references that petitioner was aware of when filing the petition reasonably could have been included in the petition); *IBM Corp. v. Intellectual Ventures II LLC*, IPR2014-01465, Paper No. 32, 6 (PTAB Nov. 6, 2015) (art that “reasonably could have raised” under § 315(e)(1) “include[es] ‘prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.’” (quoting 157 Cong. Rec. S1375)); Ex Parte Reexamination Control No. 90/014,292, DECISION GRANTING PETITION AND *SUA SPONTE* VACATING *EX PARTE* REEXAMINATION PROCEEDING (OPLA Feb. 5, 2020).

¹ Patent Owner reserves the right to challenge the prior art status of any cited reference.

Thus, Salesforce/RPX already raised reexamination grounds 1-3 as grounds 1-3 of the '1750 IPR and reasonably could have raised reexamination grounds 4-12. This calls for estoppel under 35 U.S.C. § 315(e)(1) because Salesforce/RPX “raised or reasonably could have raised” all grounds of the present reexamination in the earlier IPR.

C. The '1750 IPR is “an inter partes review ... that result[ed] in a final written decision under section 318(a)” for purposes of 35 U.S.C. § 315(e)

The '1750 IPR is “an inter partes review ... that result[ed] in a final written decision under section 318(a)” for purposes of 35 U.S.C. § 315(e)(1) because the Board issued a final written decision in the '1750 IPR. Estoppel under § 315(e)(1) “is effective as of the *issuance* of the [final] written decision.” Subsequent vacatur does not nullify the effect of its issuance (the creation of estoppel) for purposes of § 315(e)(1).

The Board issued a Final Written Decision in the '1750 IPR on December 28, 2016. *See* IPR2015-01750, Paper 128 (Judgment) at 3, 4 (PTAB Oct. 2, 2020) (designated precedential) (“the Board instituted the instant *inter partes* reviews, and later issued Final Written Decisions [with respect to] the challenged claims”, including “claims 13-18 of U.S. Patent No. 8,484,111 B2” in IPR2015-01750).

The Federal Circuit has held that “estoppel [under § 315(e)(1)] is effective as of the *issuance* of the [final] written decision”:

Subsection 315(e)(1) expressly states that, once the Board *issues* a final written decision addressing the patentability of the claims of a patent, “[t]he petitioner ... may not request or maintain a proceeding” challenging those same claims before the Board on grounds that it “raised or reasonably could have raised during that inter partes review.” That means that, regardless of when the Board memorializes its conclusion that § 315(e)(1) bars a proceeding, the estoppel is effective as of the *issuance* of the prior written decision. To read § 315(e)(1) otherwise would eviscerate the “maintain a proceeding” language in the statute.

Intuitive Surgical, Inc. v. Ethicon LLC, No. 2020-1480, -- F.4th --, 2022 WL 421189, slip op. at 12 (Fed. Cir. Feb. 11, 2022). Thus, § 315(e)(1) estoppel became “effective as of the issuance of the [final] written decision” in the ‘1750 IPR.

Subsequent vacatur of the ‘1750 IPR final written decision did not nullify the decision’s § 315 estoppel effect for at least the same reasons that subsequent dismissal of a Complaint does not nullify the Complaint’s § 315 estoppel effect. *See Cisco Systems v. Chrimar Systems, Inc.*, IPR2018-01511 (PTAB Jan. 31, 2019) (designated as precedential on Aug. 29, 2019).

In *Cisco Systems*, the Board determined that a petitioner is barred if it has previously filed an invalidity action in district court, even if it voluntarily dismissed that previously filed action. Under § 315(a)(1), a petitioner is barred if it (or its real party in interest) “filed a civil action challenging the validity of a claim of the patent.” In *Cisco Systems*, petitioner argued that because it voluntarily dismissed its previously filed district court action, the dismissal nullified the prior filing as if it never existed. The Board disagreed, extending to § 315(a)(1) the same reasoning applied in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018) (en banc), *vacated on other grounds sub nom., Thryv, Inc. v. Click-to-Call Technologies, LP*, 590 U.S. ____, 140 S. Ct. 1367, 206 L. Ed. 2d 554 (2020). In that case, the Federal Circuit held that voluntary dismissal does not nullify having been “served with a complaint” for purposes of § 315(b) estoppel.

Thus, the ‘1750 IPR is “an inter partes review ... that result[ed] in a final written decision under section 318(a)” for purposes of 35 U.S.C. § 315(e)(1).

Accordingly, based on the ‘1750 IPR, Requestor is estopped under 35 U.S.C. § 315(e)(1) from requesting reexamination of claims 13-18 of the '111 patent on all the grounds raised in the

Request, and therefore the present reexamination proceeding should be terminated for at least this reason.

IV. Reexamination Should Be Terminated Because Requester's Certification Pursuant to Rule § 1.510(b)(6), as Set Forth in Its Request, Is Improper

Patent Owner requests that the Office vacate the '069 reexamination because Requester's certification under 37 CFR § 1.510(b)(6) was improper.

Even if the Office may somehow find that Salesforce is not estopped under 35 U.S.C. § 315(e)(1) with respect to some of the grounds raised in the Request, Requestor's certification was still improper with respect to at least those grounds (grounds 1-3) that are exactly the same as grounds petitioner already raised in the '1750 IPR.

Rule § 1.510(b) provides, in pertinent part:

Any request for reexamination must include the following parts:

...

(6) A certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.

The Office has explained that if the Requestor's certification pursuant to § 1.510(b)(6) is improper with respect to **any** ground raised in the request for reexamination, the Office will vacate the **entire** proceeding:

A certification under 37 CFR 1.510(b)(6), ... is either proper or improper. If any part of the certification is improper, then the entire certification is improper. If the Office determines that any part of requester's certification pursuant to 37 CFR 1.510(b)(6) is improper, the Office will vacate the entire proceeding, including the order granting reexamination and the filing date of the reexamination proceeding.

Ex Parte Reexamination Control No. 90/014,292, DECISION GRANTING PETITION AND *SUA SPONTE VACATING EX PARTE* REEXAMINATION PROCEEDING, 10-11 (OPLA Feb. 5, 2020).

In the present reexamination, Requestor's Rule 1.510(b)(6) certification was improper because the statutory estoppel provisions of 35 U.S.C. 315(e)(1) prohibited Requestor from filing its request for reexamination. As explained in detail above, Salesforce was estopped under 315(e)(1) from filing any of the grounds in the present Request. At the very least, Requestor's certification was improper with respect to grounds 1-3 which are exactly the same as grounds 1-3 of the '1750 IPR.

Therefore Requestor's certification pursuant to Rule 1.510(b)(6), as set forth in its Request, is improper and the Office should "vacate the entire proceeding." Ex Parte Reexamination Control No. 90/014,292, DECISION GRANTING PETITION AND *SUA SPONTE VACATING EX PARTE* REEXAMINATION PROCEEDING, 10-11 (OPLA Feb. 5, 2020) ("If the Office determines that any part of requester's certification pursuant to 37 CFR 1.510(b)(6) is improper, the Office will vacate the entire proceeding").

The Office should therefore terminate the present reexamination for at least this reason.

V. Reexamination Should Be Terminated as *Ultra Vires* Because the PTO Director Failed to Serve Patent Owner with a Copy of the Reexamination Request

The reexamination should be summarily terminated for the additional reason that the PTO Director failed to promptly send a copy of the Request to Patent Owner as required by 35 U.S.C. § 302 and conducting this reexamination would therefore be contrary to law.

The statute requires the Director to promptly send a copy of a third-party reexamination request to the patent owner. 35 U.S.C. § 302 ("[u]nless the requesting person is the owner of the

patent, the Director promptly will send a copy of the request to the owner of record of the patent.”).

As of the filing of this Petition, the Patent Owner has not received from the Director a copy of the Request. There is no indication in PAIR that the Director ever attempted to send the copy required by 35 U.S.C. § 302. This is a *per se* violation of Patent Owner’s rights.

Moreover, when the requirements of 35 U.S.C. § 302 are not met, the Director should not proceed to determine whether a substantial new question of patentability exists under 35 U.S.C. § 303(a). See 35 U.S.C. § 303(a) (“Within three months following the filing of a request for reexamination under the provisions of section 302, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request.”) (emphasis added). In turn, when there is no proper determination under § 303(a) that a substantial new question is raised, there should be no order for reexamination. 35 U.S.C. § 304 (“If, in a determination made under the provisions of subsection 303(a), the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.”).

In the present case, because the Director failed to comply with their obligation under 35 U.S.C. § 302 to promptly send Patent Owner a copy of the Request, the Director had no authority to proceed to § 303 and determine whether the Request raised a substantial new question of patentability, and in turn had no authority to move on to § 304 and order reexamination of the ’111 patent. The Director’s actions (acceptance of the Request for filing, accordance of a filing date, determination whether the Request raised a substantial new question of patentability, and order that reexamination be conducted) were all *ultra vires*.

The Federal Circuit has held that termination of an improperly granted reexamination is an appropriate remedy. In particular, the Federal Circuit applied the Administrative Procedure Act to reverse the PTO, holding “the Patent Office abused its discretion by denying Vivint’s § 1.181 petitions” to terminate an instituted reexamination. *In re Vivint, Inc.*, 14 F.4th 1342, 1352 (Fed. Cir. 2021).

This reexamination should therefore be summarily terminated for this additional reason.

VI. Reexamination Should Be Terminated as *Ultra Vires* Because the ‘111 Patent Is Expired

The reexamination should be summarily terminated for the additional reason that the ‘111 patent is expired. Conducting this reexamination would be contrary to law because the reexamination statute does not apply to expired patents.

The Act establishing reexamination limits its applicability to patents that are “in force”:

Section 1 of this Act [amending Title 35 of the U.S.C. by adding new chapter 30 including new 35 U.S.C. §§ 301-307] will take effect on the first day of the seventh month beginning after its enactment and will ***apply to patents in force*** as of that date or issued thereafter.

Pub.L. No. 96–517, § 8(b). The Federal Circuit has interpreted the phrase “patents in force or issued thereafter” in that section as being limited to unexpired patents. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 597 (Fed. Cir. 1985) (“The [*ex parte* reexamination] statute took effect on July 1, 1981, and by its terms applies to **unexpired** patents issued before as well as after that date.” (emphasis added) (citing Pub.L. No. 96–517, § 8(b), 94 Stat. 3015, 3027)), *modified on other grounds on reh'g*, 771 F.2d 480 (Fed. Cir. 1985).

Other portions of the Act confirm that expired patents are not “in force.” For example, the Act added maintenance fee provisions establishing that a patent that is not maintained “in force” “will expire:”

Section 41 of title 35, United States Code, is amended to read as follows:

“§ 41. Patent Fees”

“(a) The Commissioner of Patents will establish fees for the processing of an application for a patent, from filing through disposition by issuance or abandonment, for **maintaining a patent in force**, and for providing all other services and materials related to patents. No fee will be established for maintaining a design patent in force.

....

“(c) Fees for **maintaining a patent in force** will be due three years and six months, seven years and six months, and eleven years and six months after the grant of the patent. **Unless payment of the applicable maintenance fee is received** in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, **the patent will expire** as of the end of such grace period.

Pub.L. No. 96–517, § 2 (emphasis added).

Accordingly, as stated in *Patlex*, reexamination only applies to unexpired patents.

Any other understanding would conflict with 35 U.S.C. § 305. That section grants patent owners the right to add new claims “[i]n any reexamination.” But new claims cannot be added to expired patents. By necessary implication, expired patents are not subject to reexamination.

The Federal Circuit has explained that “[t]he reexamination law, set forth [in § 305], gives patent owners the **same** right” to amend and add new claims as that given to them by § 251 to amend and add new claims in reissue proceedings. *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984) (emphasis added). Moreover, this “same right” to add new claims must be available to patent owners in each and every reexamination because § 305 expressly gives patent owners this “same right” to add new claims “[i]n any reexamination”. But new claims cannot be

added to expired patents. Thus, for this “same right” to add new claims to be available in each and every reexamination, as recognized by the Federal Circuit and demanded by the express text of § 305, expired patents cannot be subject to reexamination.

Patent owners have the right, as recognized in *In re Yamamoto*, to add new claims during reexamination. And the language of section 305 is unambiguous: patent owners have this right “[i]n any reexamination”. Thus, consistent with *Patlex*, this unambiguous language of section 305 demands that expired patents cannot be subject reexamination.

Moreover, the Federal Circuit has based decisions involving *ex parte* reexaminations on the proposition that new claims are permitted in all *ex parte* reexaminations. For example, in its decision holding that the presumption of validity does not apply in *ex parte* reexamination, the Federal Circuit stated:

In litigation, where a patentee cannot amend his claims, or add new claims, the presumption, and the rule of claim construction (claims shall be construed to save them if possible), have important roles to play. In reexamination, where claims can be amended and new claims added, and where no litigating adversary is present, those roles and their rationale simply vanish.

In re Etter, 756 F.2d 852 (Fed. Cir. 1985). This further supports that *ex parte* reexamination applies only to unexpired patents.

The Federal Circuit has held that termination of an improperly granted reexamination is an appropriate remedy. In particular, the Federal Circuit applied the Administrative Procedure Act to reverse the PTO, holding “the Patent Office abused its discretion by denying Vivint’s § 1.181 petitions” to terminate an instituted reexamination. *In re Vivint, Inc.*, 14 F.4th 1342, 1352 (Fed. Cir. 2021).

Accordingly, because the *ex parte* reexamination statute does not apply to expired patents, the Office's order granting reexamination of the expired '111 patent is contrary to law and the present reexamination must be terminated.

VII. Any Requirements of the Regulations that Would Otherwise Preclude Summary Termination of the Reexamination Should Be Waived Under 37 C.F.R. § 1.183

If any requirements of PTO regulations would preclude summary termination of the present reexamination, they should be waived under 37 C.F.R. § 1.183 because justice so requires in the extraordinary situation outlined herein.

For example, 37 C.F.R. § 1.540 provides that “[n]o submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.” However, in view of the facts and circumstances of the present case, as discussed above, Patent Owner hereby requests, under 37 C.F.R. § 1.183, the Office to waive the provisions of § 1.540 and enter and consider the instant paper prior to the issuance of a non-final action on the merits or the Office otherwise commencing examination of the present reexamination.

Justice requires waiver in these extraordinary circumstances.

A. Extraordinary Circumstances Exist

As discussed herein, extraordinary circumstances are present. For example, the reexamination request was improvidently granted on grounds the Board (including the Chief Judge and the Vice Chief Judge) already found warranted discretionary denial based on abusive filing practices in a previous IPR. The abusive practices found by the Board include:

- Salesforce filed a CBM petition against the challenged '111 patent, and the petition was denied;

- Salesforce was time-barred from filing further AIA petitions against the ‘111 patent;
- Salesforce had multiple communications with RPX concerning the ‘111 patent litigation;
- Salesforce paid RPX substantial sums of money;
- RPX filed a follow-on IPR petition against the ‘111 patent without disclosing that Salesforce was the real party in interest; and
- “RPX’s filings of these Petitions were strategically motivated, at least in part, to provide a second chance at invalidating the AIT patents to benefit Salesforce, which was time-barred from filing any additional petitions.”

After abusively seeking “a second chance”, Salesforce now abusively seeks a *third* chance to challenge the ‘111 patent by presenting the same grounds the PTAB already denied as abusive.

B. Justice Requires Waiver

Justice, due process, and fundamental fairness require termination of this reexamination and any necessary waiver of PTO regulations.

VIII. Petition Fee

The Commissioner is hereby authorized to charge to Deposit Account No. 60-0202 (98-10450) any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

IX. Relief Requested By This Petition

In light of the aforementioned circumstances, regulations, and statutes, the Patent Owner respectfully requests the following relief:

1. That the present reexamination be summarily and immediately terminated.

2. That any requirement of regulations that would otherwise prevent granting this relief be waived in the interest of justice.

Respectfully submitted,

Applications in Internet Time, LLC

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